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REMARKS

This Amendment is submitted in response to the Office Action mailed on December 16, 2003. Claims 1 - 8 and 15 - 29 are pending, and all stand rejected at present.

Previously, an amended Abstract was submitted. The Office Action identified in the paragraph immediately above requested a re-submittal, but on a single sheet, with no other material on that sheet. Such a re-submittal is made herein.

Office Action, Section 3, First Paragraph

All claims were rejected under section 112, on the grounds of alleged failure to disclose a "best mode." The PTO alleges that the steps of "identifying" and "modifying" do not meet the enablement standard.

Appellant points out that the law does not require disclosure of "best mode" in the absolute sense, but only the "best mode" contemplated by the inventor. (In re Honn, 53 CCPA 1469, 364 F. 2d 454, 461-2, 150 USPQ 652 (1966). See D. Chisum, Patents, A Treatise on the Law of Patentability, Validity and Infringement, § 7.05[1], "Chisum" herein.)

Further, in order for a "best mode" attack to prevail, it must be shown that the inventor **intentionally** concealed the best mode. Professor Chisum states:

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. . . a best mode rejection . . . on a patent will fail absent evidence that the inventor . . . knew at the time of application of a best method and yet concealed it.

(Chisum, § 7.05[1], page 7-120.)

Further still, the courts have held that, if a patent application satisfies the enablement requirement, that is sufficient to satisfy the "best mode" requirement. (Chisum, § 7.05[3]; In re Gay, 309 F. 2d 769, 135 USPQ 311 (CCPA 1962).) Of course, if enablement is provided, but the Inventor actively concealed a preferred embodiment, then it would seem that the "best mode" rule may have been violated.

Therefore,

- 1) The absolute "best mode" need not be set forth;
- 2) If enablement is provided, then the "best mode" rule is satisfied; and
- 3) To show violation of the "best mode" rule, active concealment must be shown.

The Office Action, first paragraph of section 3, asserts that, since enablement has not been shown, then "best mode" has also not been shown. The PTO relies on In re Naquin to support this assertion.

On March 16, 2004, the undersigned attorney read Naquin, and found no support for the PTO's assertion. Further, no discussion

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of best mode at all was found in Naquin.

Therefore, Applicant requests a citation of authority in support of the PTO's assertion.

Applicant points out that the Office Action is apparently making an argument of the following type:

- 1) Providing enablement means providing at least one embodiment.
- 2) Lack of enablement implies absence of all embodiments.
- 3) Thus, the absence of all embodiments implies absence of a best mode, since a "mode" is an "embodiment."

While this type of argument may bear some superficial appeal, Applicant requests a citation of authority in support of it, if, in fact, the PTO is relying on such an argument. One reason is that lack of enablement can be found for technical reasons, yet the best mode may still be present.

For example, it may be found that a given specification requires "undue experimentation," and thus is non-enabling. The undersigned attorney is unaware of a court decision which holds that such a need for "undue experimentation" implies lack of best mode.

Thus, Applicant requests a citation of authority in support of the PTO's position that lack of enablement implies lack of best

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mode.

In addition, as explained above, a "best mode" attack requires a showing of active concealment by the Applicant. No such showing has been made. The "best mode" attack lacks evidentiary support, and must fail.

Office Action, Section 3, Second Paragraph

The Office Action, first paragraph of section 3, asserts that enablement is lacking, because the "identifying" and the "modifying" steps have not been explained sufficiently to satisfy the enablement requirement. Then, in the second paragraph of section 3, the Office Action sets forth a rationale as to why enablement is absent.

The second paragraph, in essence, states that the Specification must explain how to implement the invention, except that steps which would be apparent to the skilled artisan can be omitted.

But the second paragraph merely sets forth a rule of law. Nowhere in the first and second paragraphs does the PTO state **exactly what the problem is**. MPEP § 2164.04 states:

BURDEN ON THE EXAMINER UNDER THE ENABLEMENT REQUIREMENT

. . . [T]he Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.

. . . .

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[The] Specification . . . must be taken as being in compliance with the enablement requirement . . . unless there is a reason to doubt the objective truth of the statements contained therein . . .

. . .

[It] is incumbent upon the Patent Office . . . to explain why it doubts the truth or accuracy of any statement in a supporting disclosure . . .

. . .

[T]he minimal requirement is for the Examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments.

Applicant submits that the PTO has not complied with these requirements. Paragraph 2 of section 3 merely sets forth requirements which the specification must supposedly meet. Paragraph 1 merely asserts that the "modifying" and "identifying" steps fail to provide enablement.

Thus, the **sole content**, in the present context, of the Office Action is a naked conclusion, unsupported by evidence, that the "modifying" and "identifying" steps lack enablement. That does not comply with this MPEP section. For example, this MPEP section states that "[T]he minimal requirement is for the Examiner to give reasons for the uncertainty of the enablement." Naked conclusions are not reasons.

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Point 1

In point of fact, the naked conclusions are incorrect. As to "identifying," the Specification states that an ATM or self-service terminal or system is "identified" which has specific characteristics, such as

an ATM having a display for displaying options for withdrawing cash and a touch input mechanism for receiving user commands.

(Specification, page 2, lines 6 - 8, and other locations.)

How to do that is self-evident to a person skilled in the art. For example, you walk up to an ATM, with a list of characteristics in your hand. You examine the ATM, to ascertain whether it possesses the characteristics in question.

Another example is found in an analogy to an automobile dealership. The dealer has a list, probably computerized, of all cars in stock, together with the options on each. It is self-evident that an operator of ATMs, such as a bank, would have a list of the ATMs that it owns and operates, together with the relevant characteristics of each. As a minimum, it would have a list of the model numbers of the ATMs which it owns. It could telephone the sales representative of the ATM manufacturer, and obtain a list of the characteristics of each ATM.

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In this example, a person examines the list of ATMs, to identify those having the characteristics in question.

Further, Applicant submits that no independent enablement is required for this step, apart from the claims themselves. Claim 1, for example, recites:

1. A method comprising:

identifying an ATM which has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands . . .

You can hand this claim to a high school student, and tell the student to find such an ATM. When the student does, and there is no doubt that he can, he thereby "identifies" the ATM of the claim.

In view of the foregoing, Applicant requests that the PTO justify, as required by MPEP § 2164.04, its assertion that the "identifying" step lacks enablement. That is, claim 1 states, in effect:

find an ATM which has

1) a screen for displaying options
for withdrawing cash

and

2) a touch input mechanism for
receiving user commands.

The undersigned attorney fails to see why those instructions are

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not enabling, and requests that reasons be set forth.

Point 2

In point of fact, the naked conclusions are incorrect. As to "modifying," Applicant points out that prior-art ATMs contain standard Personal Computers, PCs, which contain modems. The modems connect to hard-wired telephone lines. Commands to the ATM, such as a command to dispense cash, arrive on those lines, and are relayed by the modem to the PC.

Thus, one sequence of operation would be the following. A customer presents a passcard, and punches in a PIN. The PC relays that information to a central computer at a bank. The bank verifies the identity of the customer, and transmits verification signals to the PC. The customer requests fifty dollars. The bank verifies that the customer's account contains fifty dollars, and transmits a signal to the PC to dispense fifty dollars.

The modem involved in those transactions can be replaced by a so-called "cellular modem." Security need not be a large issue, because digital cellular telephone protocols are highly secure. That is, the cellular modem will only accept signals transmitted by its cell phone provider. Thus, in this example, a person calls the telephone number of the cellular modem, and is connected to the modem. Then, the person passes security measures, such as presenting a secret 100-digit number, which is stored in the cell

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phone, for example. The ATM is programmed to now accept commands from the modem, instead of from the usual keypad.

All of the preceding is known to a person skilled in the art from merely reading claim 1, which states in part:

. . . modifying said ATM to enable it to
receive from a wireless telephone user
commands for dispensing cash.

Further, US patent 6,175,922, cited in these proceedings, has an effective date of April 27, 1998, or earlier. That patent refers to using wireless electronic transmitters to issue commands to ATMs. For example, a command to dispense \$ 200.00 is discussed. (Column 7, lines 12 - 14.) This patent states that a portable telephone can be used as the portable device. (Column 10, line 50 et seq.)

Therefore, the '922 patent indicates that the state of the art at the time Applicant's patent application was filed explains how to construct an ATM to dispense cash in response to signals from a wireless telephone. Thus, a person skilled in the art would know how to modify an ATM as claimed.

Additional Point

If "best mode" is lacking, then the PTO must identify a mode, better than those presented in the application, which Applicant has concealed. Until that is done, the PTO's assertions are naked,

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unsupported conclusions.

That is, the PTO must specify the best mode which is absent.

RESPONSE TO OFFICE ACTION, SECTION 4

The Office Action asserts that the invention lacks utility. That is not so. The invention has a "use," namely, retro-fitting ATMs so that they can receive commands from a wireless device. That is a use, therefore making the invention "useful," thus showing utility.

RESPONSE TO OFFICE ACTION, SECTION 6

Section 6, first paragraph, asks questions which Applicant is not required to answer. This paragraph asks whether the invention is "identifying an ATM or modifying an ATM."

Applicant is not required to answer such questions. The claims **as-a-whole** define the invention. Applicant is not required to choose parts of the claim which are considered to be the invention.

Further, 35 USC § 112 states that the Applicant determines what he "regards as" the invention. In this case, Applicant did so using the language of the claims. Applicant is not required to now choose sub-sets of the claims, and rely on those as the invention.

Further still, this paragraph of the Office Action is

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attempting to reduce the invention to a "gist." That is not allowed. MPEP § 2141.02, second heading, states:

Distilling the Invention down to a "Gist" or
"Thrust" . . . disregards "as a whole"
requirement.

The second paragraph of section 6 merely sets forth rules on claiming, but does not state how Applicant failed to follow the rules. Thus, the second paragraph is not relevant.

RESPONSE TO OFFICE ACTION, SECTION 7

Section 7 asserts that the terms "modifying" and "retrofitting" are vague and indefinite. However, the Office Action is reading those terms in isolation. That is not allowed. Each claim sets forth specific actions or elements which are included in the modification process.

This also applies to the term "retrofit." One definition is "to furnish, as in a computer, airplane or building, with new or modified parts not available or considered unnecessary at the time of manufacture." Each claim using that term sets forth specific actions or elements which are included in the modification process.

Restated, no claim uses the terms "modify" or "retrofit" without further explanation. The Office Action, in effect, is asserting that those terms, taken in isolation, are unclear. That is not the test of indefiniteness.

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Further, no evidence of indefiniteness has been given, only a naked conclusion. The PTO must show, for example, a situation wherein it would not be clear whether the claim covers the situation or not.

RESPONSE TO OFFICE ACTION, SECTIONS 9, 10

Rejections are Procedurally Incorrect

The Office Action lists a collection of elements supposedly found in Suer's ATM. (Office Action, page 5.) Then the Office Action asserts that Suer fails to show controlling an ATM using a wireless device, and that another reference, Terranova, shows that.

That approach fails to show the claims.

The elements of each claim individually must be shown in the references.

Office Action is Self-Contradictory

On the one hand, the Office Action, bottom of page 5, asserts that Suer has been retro-fitted to allow transactions to be executed using a wireless telephone.

On the other hand, the Office Action, middle of page 6, asserts that "Suer fails to show a wireless phone to withdraw cash from an ATM."

Those statements are mutually contradictory.

Further, those statements are critical to the PTO's chain-

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of-reasoning in making an obviousness rejection. The rejection necessarily fails.

Office Action is Defective

The Office Action, section 10, first paragraph, sets forth a nearly verbatim copy of claim 1, and asserts that the contents of that copy are found in Suer.

That means that the rejection of claim 1 must be based on anticipation, and not obviousness. By its terms, section 103 only applies when a claim is not shown in a single reference. The Office Action has thus admitted that claim 1 cannot be rejected under section 103.

Office Action makes no Sense

The Office Action, page 5, repeatedly asserts that Suer shows use of a wireless telephone in various capacities.

Then on page 6, middle, the Office Action states that Suer fails to show using a wireless phone to withdraw cash from an ATM. That directly contradicts, for example, the statement on page 5, stating that Suer shows "[receiving] from a wireless telephone user commands for dispensing cash."

That makes no sense. Nonsense cannot be the basis of a rejection.

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Office Action, Section 10, First Paragraph, is False

The first paragraph asserts that Suer performs certain "identifying." However, the claims recite identifying an ATM, which is a **pre-existing** entity. The Suer reference does not identify an existing ATM.

In connection with the issue of "identifying" an ATM and then "modifying" it, the undersigned attorney downloaded the Suer reference from the PTO's web site, and searched for words containing "modif." No results were obtained.

Then a search for "ident" and "locat" was made. The following results were obtained:

column 2, line 19, which states that a user must "identify himself";

column 6, line 50, and column 11, line 43, both of which refer to a "personal identification number (PIN);

column 13, line 24, 25, both of which refer to a "unique identification" which the PDA uses to identify itself;

column 14, line 8, which refers to identifying a data packet;

column 14, line 14, which refers to an "identical data packet;"

column 15, line 45, which refers to identification of an "information storage device" from which data was received; and

column 18, line 48, which refers to a "merchant's location."

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Therefore, since relevant words such as "modify," "modification," and "identify," appear to be absent from Suer, Applicant requests the PTO to explain how Suer shows identification of the ATM (or SST) as claimed. That is, for example, none of the passages in Suer using a word containing "ident" have any relevance to identification of an ATM, as claimed. Given that fact, where does Suer discuss "identification" ?

In addition, the undersigned attorney searched Suer for the following terms: "phone," "telephone," "cell," and "wireless." The search indicated that those character strings are not present in Suer (at least not in the text). The undersigned attorney examined the Figures in Suer, and can find nothing resembling a telephone or cell phone.

Claim 1 recites

. . . modifying said ATM to enable it to receive from a **wireless telephone** user commands for dispensing cash.

No "wireless telephone" appears to be present in Suer.

Therefore, the following three elements are absent from Suer:

- 1) identification of an ATM having the claimed characteristics;
- 2) modifying that ATM;
- 3) modifying to thereby allow a wireless telephone to perform certain functions.

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Consequently, section 10, first paragraph, of the Office Action is not correct.

Office Action, Section 10, Second Paragraph, is False

The second paragraph states that a transceiver is present in Suer which transmits signals to a wireless telephone.

As explained above, no wireless telephone is present in Suer. The second paragraph is false.

Office Action, Section 10, Third Paragraph, is False

The third paragraph states that the signals of the second paragraph implement local wireless communication.

As just explained, those signals are absent, because no wireless phones are found in Suer. The third paragraph is false.

Office Action, Section 10, Fourth Paragraph, is False

The fourth paragraph makes no sense. It refers to "said wireless device," but no such device is mentioned previously.

Also, it refers to a modification which, as explained herein, is absent from Suer.

Further, this paragraph is irrelevant. It states that the modification provides a connection between a "network" and "said wireless device." No claim recites that.

Further, the "network" in question is an ATM network. It is

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well known that nobody is allowed to connect to that network, apart from banks who control the ATMs, and certain other authorized parties. However, members of the general public are never granted access to an ATM network. The fourth paragraph contradicts common sense and established engineering practice. AND it is not found in Suer.

Office Action, Section 10, Fifth Paragraph, is False

The fifth paragraph asserts that a modifying step in Suer enables a transceiver to receive signals from a wireless telephone. However, as explained herein, no wireless telephone is found in Suer. The fifth paragraph is false.

In addition, the fifth paragraph contradicts the fourth paragraph. In those paragraphs, the same modification is said to do different, and contradictory, things.

Office Action, Section 10, Sixth Paragraph, is False

The sixth paragraph states that the transceiver in Suer is connected to the "system bus," and relies on Suer, column 4, lines 30 - 42. Suer does not show such a connection.

That location in Suer states that an IR adapter is connected to "the terminal unit's serial, parallel, Universal Serial Bus (USB) or IrDA port." None of those elements qualify as the "system bus."

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It is well known that the "system bus" contains two elements:

- 1) the data lines, which run from memory to the microprocessor, and perhaps between other elements, and
- 2) the address lines, which also run between memory (actually, a memory controller) and the microprocessor.

It may also contain control lines.

For example, when the microprocessor wants to read data from memory, it would place the address of the data onto the address lines, or address bus. It may then pull a control line, indicating a request for data.

A memory controller receives the address, locates the data at that address, and places the data onto the data bus. The controller may pull a control line, indicating that the data is ready. (This can be necessary to force the microprocessor to wait until the data stabilizes before attempting to read the data.)

This type of "system bus" is a completely different entity from the ports mentioned in Suer, column 4, lines 30 - 42. One reason is that, in general, a computer can exist, and perform computation, without those ports. For example, a word processor operating on a PC can operate with no trouble at all without serial ports or parallel ports. Printing on a printer may not be possible, but that can be remedied by copying the document to a

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diskette, and printing elsewhere.

However, if a "system bus" were absent, the PC could not operate at all.

Restated, the "system bus" is a necessary part of the computer, and is necessary for the microprocessor to operate. That is not so with Suer's ports.

They do not correspond to the recited "system bus."

The sixth paragraph is false.

Office Action, Section 10, Seventh Paragraph, is False

The seventh paragraph asserts that Suer shows a retrofit which allows a wireless telephone to execute transactions, where such a telephone could not do so before. That is simply not found in Suer.

Office Action, Section 10, Eighth Paragraph, is False

The eighth paragraph is somewhat similar to the seventh, and is not found in Suer at all.

Interim Conclusion

The rejection necessarily cannot stand, because it is based on false premises, as just explained.

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No Teaching Given for Combining References

The rationale given by the PTO for combining the references must contain typographical errors, because it makes no grammatical sense. That rationale is this:

It would have been obvious . . . to equip an ATM that does not have the remote control communication system by using Suer's device to communicate via a transponder/receiver as taught by Terranova to conduct business wirelessly.

This appears to make no sense. It says that Terranova teaches the use of Suer's device. That is false. Terranova does not mention Suer. Further, which "device" in Suer is being discussed ?

This rationale appears to make no sense. It says that you can "equip an ATM" by "using Suer's device." What device ? How does that device "equip" and ATM. What does that mean ? If Suer shows an ATM, which he does, and he shows the "device," what does it mean to say that he then "equips" the ATM with that device ? If the device is already present in Suer, how is "equipping" done ?

This rationale appears to make no sense. It refers to "an ATM that does not have the remote control communications system." No such ATM is shown in Suer. And both references refer to some type of remote control system. Thus, the absence of remote control is not found in the references.

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And the part which may make sense ("to do business wirelessly") does not lead to the combination of references. Each reference, by itself, "does business wirelessly."

No teaching for combining the references has been given.

Cell Phone Absent from Terranova

Terranova is cited to show a cell phone. The undersigned attorney can find no mention of cell phones in Terranova. And the Office Action has cited no passage in Terranova in support of its position. MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.


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Conclusion

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


Gregory A. Welte
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd.
WHQ - 5
Dayton, OH 45479
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(937) 445 - 4956
WELTE DIRECT: (765) 296 - 4699